

## **REMARKS**

### **The Present Invention**

The present invention provides for novel heterocyclic dihydropyrimidine compounds, pharmaceutical compositions containing such compounds and methods of using such compounds as inhibitors of ion channel function.

### **Amendments to the Claims**

Claims 81 and 91 have been cancelled. Claims 61, 63, 66, 78, 82 and 92-95 have been amended in response to a restriction requirement and/or to claim subject matter that applicants believe satisfy the statutory requirements for allowance. The amendments contain matter that may be found in the specification as originally filed, for example, at page 11, line 5 to page 13, line 14, the Examples and the original claims. Accordingly, no new matter has been added by way of the aforesaid amendments.

### **The Pending Claims**

Claims 61, 63, 66-68, 78, 82-85 and 92-96 are now pending in this application. Claims 81 and 91 have been cancelled. Claims 62, 64, 65 and 80 have been withdrawn from consideration in view of a restriction requirement. In an Advisory Action dated July 15, 2005, it was noted that claims 86-90 (now claims 91-95) set forth in applicants' response to the Final Rejection dated April 25, 2005 filed on June 27, 2005 were not entered because they would raise new issues that would require further consideration. Claims 61, 63, 66-68, 78, 82-85 and 92-96 provide for novel heterocyclic compounds, pharmaceutical compositions containing such compounds and methods of using such compounds as inhibitors of ion channel function.

### **The Office Action**

In the Office Action dated May 19, 2006, claims 61-63, 66-68, 78, 81-85 and 91-96 were rejected under 35 U.S.C. §103(a) for allegedly being unpatentable in view of the prior art.

In addition, the Office Action dated May 19, 2006 contended on page 2 that claims 61-63, 66-79 and 81-83 contain non-elected subject matter.

#### Rejection under 35 USC § 103

Claims 61-63, 66-68, 78, 81-85 and 91-96 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tsuda et al. (European Patent EP 0217142). The Office Action contends that the recited reference includes structural analogs or homologs, and contends at page 4, that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the reference compounds to prepare the structural homologs, that one of ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds are expected to possess similar properties, and that case law supports a holding of *prima facie* obviousness.

Without acceding to the correctness of this contention, in order to expedite the prosecution of this application, applicants have hereby amended claims 61, 66, 78, and 82 so that Z<sup>5\*</sup> and Z<sup>6\*</sup> taken together may not be unsubstituted piperidinyl, substituted piperidinyl, unsubstituted pyrrolidinyl, or unsubstituted morpholinyl. However, applicants respectfully reserve the right to pursue said subject matter in a continuation application. Because the Section 103 rejection has been rendered moot by the aforementioned amendments, applicants respectfully request withdrawal of this rejection.

#### Non-elected Subject Matter

The Office Action contends on page 2 that claims 61-63, 66-79 and 81-83 contain non-elected subject matter. However, the Examiner indicated via the telephone conversation that applicant's attorney had with the Examiner on July 18, 2006 that the claims would be allowable if rewritten to claim the subject matter wherein R<sup>2</sup> is phenyl or substituted phenyl and R<sup>3\*</sup> is – C(O)NZ<sup>5\*</sup>Z<sup>6\*</sup>, wherein Z<sup>5\*</sup> and Z<sup>6\*</sup> are taken together with the nitrogen atom to which they are bonded to form a heterocyclic group or substituted heterocyclic group. While applicants do not agree with this contention, in an order to expedite prosecution of the application, applicants have amended the claims to claim the subject matter identified by the Examiner in the telephone conversation that applicants' attorney had with the Examiner on July 18, 2006. However,

applicants reserve the right to pursue the subject matter claimed in original claims 61-63, 66-68, 78, 81-85 and 91-96 in a continuation application.

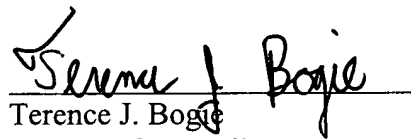
Conclusion

The presently submitted amendment and remarks are believed to be fully responsive to the rejection noted in the outstanding Office Action. Accordingly, applicants respectfully submit that the pending claims are in condition for allowance. An early Office Action to that effect is, therefore, earnestly requested.

The Commissioner is hereby authorized to charge any fees that may be required, including any fees under 37 C.F.R. §§1.16 and 1.17, for the filing of this paper to Deposit Account No. 19-3880.

If, in the opinion of the Examiner, a telephone conference with the undersigned would facilitate prosecution of this patent application, the Examiner's call would be welcomed.

Respectfully submitted,



Terence J. Bogue  
Attorney for Applicants  
Registration No. 44,544  
Telephone No. (609) 252-6385  
Facsimile No. (609) 252-4526

Date: July 19, 2006

**Please forward all future correspondence relating to this application to:**

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000